



UNITED STATES DEPARTMENT OF COMMERCE

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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.
09/532,144	03/21/00	SCHALLNER	M 1109

IM22/0718

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EXAMINER
ZIMMERMAN, J

ART UNIT	PAPER NUMBER
1775	6

DATE MAILED: 07/18/01

Please find below and/or attached an Office communication concerning this application or proceeding.

Commissioner of Patents and Trademarks

Office Action Summary

Application No.

09/532,144

Applicant(s)

Schallner et al.

Examiner

John J. Zimmerman

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-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE ____ MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136 (a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☐ This action is FINAL. 2b) ☒ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-11 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 1-11 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claims ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☒ The drawing(s) filed on 3/21/0 is/are objected to by the Examiner.
- 11) ☐ The proposed drawing correction filed on ____ is: a) ☐ approved b) ☐ disapproved.
- 12) ☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. § 119

- 13) ☒ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☒ All b) ☐ Some * c) ☐ None of:
1. ☒ Certified copies of the priority documents have been received.
2. ☐ Certified copies of the priority documents have been received in Application No. ____.
3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.
- 14) ☐ Acknowledgement is made of a claim for domestic priority under 35 U.S.C. § 119(e).

Attachment(s)

- 15) ☒ Notice of References Cited (PTO-892)
- 16) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 17) ☒ Information Disclosure Statement(s) (PTO-1449) Paper No(s) 5.
- 18) ☐ Interview Summary (PTO-413) Paper No(s) ____.
- 19) ☐ Notice of Informal Patent Application (PTO-152)
- 20) ☐ Other: _____

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OFFICE ACTION

Priority

1. Receipt is acknowledged of papers submitted under 35 U.S.C. 119(a)-(d), which papers have been placed of record in the file.

Information Disclosure Statement

2. The Information Disclosure Statement filed April 19, 2000 has been considered. An initialed form PTO-1449 is enclosed with this Office Action.

Drawings

3. Figure 1 should be designated by a legend such as --Prior Art-- because only that which is old is illustrated. See MPEP § 608.02(g).

Claim Objections

4. Claims 1-11 are objected to because of the following informalities: The reference characters to the drawings in the claims should be deleted from the claims since they are extraneous and have no effect on claim interpretation. Reference characters to the drawings have

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no effect on the scope of the claims (e.g. see MPEP 608.01(m)). Appropriate correction is requested.

Claim Rejections - 35 USC § 102

5. The following is a quotation of the appropriate paragraphs of 35 U.S.C. 102 that form the basis for the rejections under this section made in this Office action:

A person shall be entitled to a patent unless --

(b) the invention was patented or described in a printed publication in this or a foreign country or in public use or on sale in this country, more than one year prior to the date of application for patent in the United States.

6. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Cerniglia (U.S. Patent 3,556,951)

7. Cerniglia discloses a thin layer sequence on a substrate wherein a thin layer of gold (e.g. column 4, lines 40-42; see numeral 37 in Figure 9) may be sputter deposited (e.g. column 4, lines 9-10) and a further layer of electroplated gold may be deposited on the sputtered gold layer so that the electroplated gold may vary in thickness over the surface of the sputtered gold layer (e.g. see column 5, lines 28-36; see numeral 42b in Figure 8; see numeral 46 in Figure 9). The reference may not recite the formation of any "regions to be adjusted", but the reference meets all the physical requirements of the claims since the only physical structure required by the claims is a sputtered layer and a nonsputtered layer of variable thickness over the sputtered layer. No

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particular type of electrical device is claimed. The function of reinforcing would be inherent to the thickness of the nonsputtered layer even though not stated as such by the reference. The recitation of the step of adjusting in the claims is merely a future intended function and does not impact on the structure of the physical article configuration required by the pending claims. The fact that the reference may not intend any adjustment is not material since the reference meets all the physical limitations of the rejected claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The structure of the reference is certainly capable of meeting the intended use recited by applicant. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Although it is noted that the claims refer to reference characters to facilitate description of the claimed

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subject matter, reference characters to the drawings have no effect on the scope of the claims (e.g. see MPEP 608.01(m))

8. Claims 1-2 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Lifshin (U.S. Patent 4,357,395)

9. Lifshin discloses a thin layer sequence wherein a thin layer of copper may be sputter deposited and a further layer of electroplated copper is adjacent the sputtered copper layer so that the electroplated copper layer varies in thickness over the surface of the sputtered copper layer (e.g. see Figure 6). The reference may not recite the formation of any "regions to be adjusted", but the reference meets all the physical requirements of the claims since the only physical structure required by the claims is a sputtered layer and a nonsputtered layer of variable thickness over the sputtered layer. No particular type of electrical device is claimed. The function of reinforcing would be inherent to the thickness of the nonsputtered layer even though not stated as such by the reference. The recitation of the step of adjusting in the claims is merely a future intended function and does not impact on the structure of the physical article configuration required by the pending claims. The fact that the reference may not intend any adjustment is not material since the reference meets all the physical limitations of the rejected claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the

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prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The structure of the reference is certainly capable of meeting the intended use recited by applicant. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Although it is noted that the claims refer to reference characters to facilitate description of the claimed subject matter, reference characters to the drawings have no effect on the scope of the claims (e.g. see MPEP 608.01(m))

10. Claims 1-2 and 7-9 are rejected under 35 U.S.C. 102(b) as being anticipated by Tabuchi (U.S. Patent 5,015,338)

11. Tabuchi discloses a thin layer sequence wherein a thin conductive layer may be sputter deposited and a further layer of electroplated conductive metal is adjacent the sputtered layer so that the electroplated layer varies in thickness over the surface of the sputtered layer (e.g. see

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Figure 2D). The reference may not recite the formation of any "regions to be adjusted", but the reference meets all the physical requirements of the claims since the only physical structure required by the claims is a sputtered layer and a nonsputtered layer of variable thickness over the sputtered layer. No particular type of electrical device is claimed. The function of reinforcing would be inherent to the thickness of the nonsputtered layer even though not stated as such by the reference. The recitation of the step of adjusting in the claims is merely a future intended function and does not impact on the structure of the physical article configuration required by the pending claims. The fact that the reference may not intend any adjustment is not material since the reference meets all the physical limitations of the rejected claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The structure of the reference is certainly capable of meeting the intended use recited by applicant. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior

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art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Although it is noted that the claims refer to reference characters to facilitate description of the claimed subject matter, reference characters to the drawings have no effect on the scope of the claims (e.g. see MPEP 608.01(m))

12. Claims 1-11 are rejected under 35 U.S.C. 102(b) as being anticipated by Ghezzi (U.S. Patent 5,454,904)

13. Ghezzi discloses a thin layer sequence on a substrate wherein a thin layer of gold is sputter deposited and a further layer of electroplated gold is deposited on the sputtered gold layer so that the electroplated gold varies in thickness over the surface of the sputtered gold layer (e.g. see column 11, line 64 - column 12, line 8; Figure 1). The reference may not recite the formation of any "regions to be adjusted", but the reference meets all the physical requirements of the claims since the only physical structure require by the claims is a sputtered layer and a nonsputtered layer of variable thickness over the sputtered layer. No particular type of electrical device is claimed. The function of reinforcing would be inherent to the thickness of the nonsputtered layer even though not stated as such by the reference. The recitation of the step of adjusting in the claims is merely a future intended function and does not impact on the structure of the physical article configuration required by the pending claims. The fact that the reference may not intend any adjustment is not material since the reference meets all the physical limitations of the rejected

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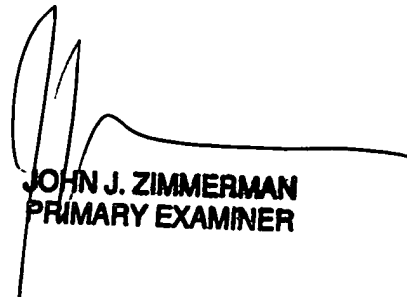
claims. A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art. If the prior art structure is capable of performing the intended use, then it meets the claim. See *In re Casey*, 152 USPQ 235 (CCPA 1967) and *In re Otto*, 136 USPQ 458, 459 (CCPA 1963). The structure of the reference is certainly capable of meeting the intended use recited by applicant. Patent and Trademark Office can require applicants to prove that prior art products do not necessarily or inherently possess characteristics of claimed products where claimed and prior art products are identical or substantially identical, or are produced by identical or substantially identical processes; burden of proof is on applicants where rejection based on inherency under 35 U.S.C. § 102 or on prima facie obviousness under 35 U.S.C. § 103, jointly or alternatively, and Patent and Trademark Office's inability to manufacture products or to obtain and compare prior art products evidences fairness of this rejection, *In re Best, Bolton, and Shaw*, 195 USPQ 431 (CCPA 1977). Although it is noted that the claims refer to reference characters to facilitate description of the claimed subject matter, reference characters to the drawings have no effect on the scope of the claims (e.g. see MPEP 608.01(m))

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Conclusion

14. The prior art made of record and not relied upon is considered pertinent to applicant's disclosure. The cited prior art serves to further establish the level of ordinary skill in the art at the time the invention was made.

15. Any inquiry concerning this communication or earlier communications from the examiner should be directed to John Zimmerman whose telephone number is (703) 308-2512 and whose fax number is (703) 305-5408.



**JOHN J. ZIMMERMAN
PRIMARY EXAMINER**

jjz
July 13, 2001